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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,619	11/17/2000	Harold P. Mintz	12763	5426
25570	7590	11/24/2006	EXAMINER	
ROBERTS, MLOTKOWSKI & HOBBS			HAMILTON, LALITA M	
P. O. BOX 10064			ART UNIT	
MCLEAN, VA 22102-8064			PAPER NUMBER	

3691

DATE MAILED: 11/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/714,619	MINTZ, HAROLD P.	
	Examiner	Art Unit	
	Lalita M. Hamilton	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Summary

March 6, 2006, an Office Action was sent to the Applicant rejecting claims 1-19 and 21-25. On August 7, 2006, the Applicant responded by amending claims 1-7, 9-18, and 23-25.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-19 and 21-25 are rejected under 35 U.S.C. 102(e) as being anticipated by Prokoski (2002/0046038).

Prokoski discloses a method and corresponding system for establishing value and financing of intellectual property comprising operating a venture capital investment business, establishing a business entity (p.2, 18-19; p.4, 69; and p.5, 80-82); said business entity establishing an investment fund for venture capital, establishing a fund managing entity of said investment fund, said fund managing entity attending to administrative matters relating to said investment fund and making investment decisions for the fund (p.2, 18-19; p.4, 69; and p.5, 80-82), the investment fund having capital contributions provided by investors in the fund (p.2, 18-19; p.4, 69; and p.5, 80-82), said

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fund managing entity also providing capital contributions to said fund, said fund utilizing said contributions to invest in portfolio entities, said investors receiving a general participation interest in said fund, and said fund managing entity receiving a carried interest in said fund, and providing said investors that have provided at least a threshold capital contribution to said fund with stock rights in said business entity to enable such investors to become shareholders in said business entity (p.2, 18-19; p.4, 69; and p.5, 80-82—a business entity is formed and has rights to obtains assets and establishes a trust to hold the assets); a business entity securing a portion of IPO shares that become available in portfolio entities, and business entity enabling shareholders thereof to purchase IPO shares said portion of IPO shares secured by said business entity that become available in said portfolio entities (p.2, 18-19; p.4, 69; and p.5, 80-82); shareholders of said business entity will be entitled to a percentage of said portion of IPO shares that is based on a pro-rata percentage of their stock ownership in said business entity, less any shares allocated otherwise (p.2, 18-19; p.4, 69; and p.5, 80-82); an amount of IPO shares that said at least one other fund managing entity is entitled to obtain is based upon the performance of said fund and/or tenure of said at least one other fund managing entity (p.2, 18-19; p.4, 69; and p.5, 80-82); fund managing entity employs at least one other fund managing entity to direct investment decisions, said at least one other fund managing entity also being provided with stock rights in said business entity (p.2, 18-19; p.4, 69; and p.5, 80-82); portfolio entities also receive stock rights in said business entity (p.2, 18-19; p.4, 69; and p.5, 80-82); shareholders in said business entity include direct shareholders in business entity, the

investors in the fund that have exercised stock options that they obtained in said business entity, the managers of the at least one other fund managing entity that has exercised stock options that it obtained in said business entity, and said portfolio entities that have exercised stock options that they obtained in said business entity (p.2, 18-19; p.4, 69; and p.5, 80-82); business entity invests directly in additional portfolio entities, other than said portfolio entities invested in through said investment fund (p.2, 18-19; p.4, 69; and p.5, 80-82); an investment manager/advisor that provides investment advice to the fund (p.2, 18-19; p.4, 69; and p.5, 80-82); business entity establishes a family of investment funds, each of said funds investing in associated portfolio entities, providing investors that have provided at least a threshold capital contribution to at least one of said funds stock rights in said business entity to enable such investors to become shareholders in said business entity, and said business entity enabling shareholders thereof to purchase shares that become available in any of said portfolio entities of said family of funds (p.2, 18-19; p.4, 69; and p.5, 80-82); portfolio entities are also provided with stock rights in the business entity (p.2, 18-19; p.4, 69; and p.5, 80-82); investment fund having investors that provide capital contributions to said fund, said fund managing entity also providing capital contributions to said fund, said fund utilizing said capital contributions to invest in portfolio entities, and providing investors that have provided a threshold capital contribution amount to said fund with stock rights to purchase shares in said business entity (p.2, 18-19; p.4, 69; and p.5, 80-82); investors are provided with stock rights to purchase shares in the business entity partial consideration for said shareholders agreeing for said business entity to secure rights

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(p.2, 18-19; p.4, 69; and p.5, 80-82); wherein receiving capital contribution information includes receiving an investor identifier associated with the investor, and based at least in part on a correspondence between the investor and the capital contribution information, retrieving the capital contribution information from a computer storage element (p.2, 18-19; p.4, 69; and p.5, 80-82); wherein allocating stock rights to the investor includes receiving a fund identifier associated with the fund and based at least in part on a correspondence between the fund identifier and the total capital contribution amount, retrieving the total capital contribution amount from a computer storage element (p.2, 18-19; p.4, 69; and p.5, 80-82); rights may be options or warrants (p.2, 18-19; p.4, 69; and p.5, 80-82—may be any type of stock right); wherein allocating stock rights to the investor includes calculating a stock ownership percentage in the business entity, wherein said stock ownership percentage is based at least in part on the relation between the capital contribution information and a total capital contribution amount (p.2, 18-19; p.4, 69; and p.5, 80-82); and a data storage medium, said data storage medium having machine-readable code stored thereon, the machine-readable code including instructions executable by an array of logic elements, the instructions defining a method comprising receiving capital contribution information relating to an amount of capital contributed by an investor to a venture capital fund, the fund having investments in a portfolio entities and comparing the capital contribution information to a threshold value (p.2, 18-19; p.4, 69; and p.5, 80-82).

Response to Arguments

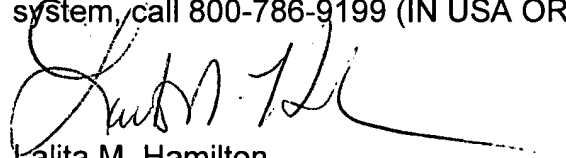
Applicant's arguments with respect to claims 1-19 and 21-25 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lalita M. Hamilton whose telephone number is (571) 272-6743. The examiner can normally be reached on Tuesday-Thursday (6:30-2:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kalinowski Alexander can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Lalita M. Hamilton
Primary Examiner, 3691